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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91181621
Party	Plaintiff StonCor Group, Inc.
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Attachments	16 JUNE 2011 RECONSIDERATION REQUEST.pdf (6 pages)(47323 bytes)

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

StonCor Group, Inc.	:	
	:	
Opposer	:	
v.	:	Opposition 91181621
	:	
	:	Application 76/650,832
	:	
Les Pierres Stonededge, Inc.	:	Mark: STONEDGE
	:	
Applicant	:	

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**STONCOR'S REQUEST FOR RECONSIDERATION
OF THE BOARD DECISION DATED 16 MAY 2011**

StonCor hereby requests reconsideration of the Board's Decision of 16 May 2011
dismissing the instant opposition.

StonCor requests reconsideration on two bases.

StonCor's first basis is this: After being advised by StonCor of the existence of case law
establishing a presumption of administrative correctness attaching to trademark applications
approved for publication by the United States Patent and Trademark Office, the Board failed
even to recognize such case law, much less apply it, and consequently improperly characterized
StonCor's witness Mr. Jewell's rebuttal testimony, holding that StonCor had failed to sustain its

evidentiary burden. This basis for requesting reconsideration is set forth in more detail in StonCor's accompanying Renewed Motion for Leave to File Supplemental Brief Accompanying and Forming a part of StonCor's Request for Reconsideration of the Board's Decision of 16 May 2011

StonCor's second basis for seeking reconsideration is inconsistency in the Board's decision of 16 May 2011. In the decision and opinion, the Board stated in part as follows:

It is well established that the issue of likelihood of confusion herein must be determined based on an analysis of the goods recited in applicant's application vis-à-vis the goods identified in opposer's pleaded registrations. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846; and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992). Thus, we can consider any of the goods listed in the identifications in opposer's registrations, regardless of the specific terms that arguably comprise opposer's principal product (flooring). Moreover, likelihood of confusion may be found based on any item that comes within the identification of goods in the involved registrations and application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Thus, where the goods in an involved registration and/or application are broadly identified as to their nature and type (as in the cases of opposer's "mortars" and "grouts" as well as opposer's "adhesives" and "bonding agents", and applicant's "precast decorative stone"), such that there is an absence of any restrictions as to the channels of trade and no limitation as to the classes of purchasers, **it is presumed that in scope the identification of goods encompasses all the goods of the nature and type described therein, that the identified goods are offered in all channels of trade which would be normal therefor, and that they would be purchased by all potential buyers thereof**¹. *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139 (CCPA 1958); and *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Opposer, in its brief and remarks at the oral hearing, focused its attention on its mortars, grouts, adhesives and bonding agents. In comparing the goods, we likewise have focused our attention on these products as they are

¹ StonCor has added emphasis to certain of the excerpts from the Board's 16 May 2011 decision.

the ones arguably closest to applicant's precast decorative stone, thus presenting opposer's strongest case for sustaining the opposition.

It is well settled that the goods of the parties need not be identical or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.* 223 USPQ 830 (TTAB 1984).

In view of the above legal constraints, **we assume that opposer's "mortar" and "grouts", as well as opposer's "liquid applied adhesives...for masonry surfaces" and "latex based bonding agents" may be used in a variety of applications, including the installation of decorative stones; likewise, applicant's "precast decorative stone" may be used in a variety of applications, including certain applications that may require the use of mortar, grout, adhesives or bonding agents when being installed,** such as architectural facades, patios, walkways, steps and walls.

Given the broad identification of goods, opposer's "mortars," "grouts," "adhesives" and "bonding agents" are, at best, complimentary to applicant's "precast decorative stone." We hasten to add, however, that the goods are distinctly different, and the record is devoid of any evidence to show that the goods are, in fact, complementary.

The goods, as identified, are presumed to move in similar trade channels (e.g., building supply outlets) and may be purchased by the same individuals (e.g., contractors, builders and the like).

To the extent that the goods may be complementary (and we reiterate that the record does not establish this fact), this purported

conjoint use, in and of itself, is an insufficient basis upon which to find that the goods are commercially related.

It is appropriate and proper for the Board to use common, everyday knowledge in determining facts in the course of making decisions as to likelihood of confusion and whether a trademark opposition should be sustained.

It is well within the common knowledge of any ordinary person, let alone an educated professional Administrative Law Judge such as the members of the Trademark Trial and Appeal Board, that mortar, grout and adhesives for masonry surfaces are necessarily used with precast decorative stone. Indeed, the Board itself in the passage set forth above assumed that StonCor's **mortar** and grout, as well as StonCor's liquid applied adhesives for masonry surfaces and latex bonding agents could be used in the installation of "decorative stone".

StonCor respectfully submits that the Board went out of its way to unnecessarily make a fact-finding of lack of relatedness as between the goods of the respective parties. For the Board to say in one place that StonCor's mortar, grouts, adhesives and bonding agents are "at best" complementary to Les Pierres pre-cast decorative stone, then to state that the goods are distinctly different, and that this somehow shows that the respective parties' goods are not complementary, is sophistry.

The issue is not whether the goods are identical; StonCor has never so-contended. The issue is whether the goods are complementary. Mortar is known by everyone, even adolescents of secondary school age, to be used to secure stone together. Mortar has no other use. For the Board to require some evidence that mortar *could* be used to secure stone in place was improper and rested on an overly technical interpretation of the law regarding proof requirements respecting complementary goods.

For the Board to state in one place that the identification of goods is presumed to encompass all goods of the nature and type described therein, and that the identified goods are offered in all channels of trade which would be normal therefor and would be purchased by all potential buyers thereof, and yet to state in another place that there is no evidence to suggest that the goods are of a type that would ever emanate from a common source much less that purchasers would expect this, represents an overly technical application of the law of evidence². It ignores common sense and common knowledge. This “logic” manifests reversible error by the Board.

In light of the foregoing and StonCor’s accompanying Renewed Motion for Leave to File Supplemental Brief, forming a part of this Request for Reconsideration of the Board’s Decision of 16 May 2011, StonCor respectfully requests reconsideration of the Board’s Decision of 16 May 2011 and issuance of an order sustaining the opposition. In the alternative, StonCor requests leave to file a Supplemental Brief in accordance with the accompanying renewed motion.

Respectfully submitted,

Date: 16 June 2011

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² If there is a presumption in a party’s favor, as the Board stated, there is no need for that party to submit evidence unless the presumption were rebutted by the party’s opponent.

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Applicant	:	

CERTIFICATE OF SERVICE

I, Charles N. Quinn, of full age, by way of certification, state that a copy of the foregoing paper was served on applicant's counsel on the date set forth below via first class mail, postage prepaid, addressed as follows:

James R. Menker, Esquire
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Date: 16 June 2011

/Charles N. Quinn/

Charles N. Quinn